

ESTTA Tracking number: **ESTTA304363**

Filing date: **09/03/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91178539
Party	Plaintiff SmithKline Beecham Corporation
Correspondence Address	Glenn A. Gundersen Dechert LLP Cira Centre, 2929 Arch Street Philadelphia, PA 19104-2808 UNITED STATES glenn.gundersen@dechert.com
Submission	Reply in Support of Motion
Filer's Name	Erik Bertin
Filer's e-mail	erik.bertin@dechert.com, glenn.gundersen@dechert.com, trademarks@dechert.com
Signature	/erik bertin/
Date	09/03/2009
Attachments	AQUAJETT Reply Brief.pdf (8 pages)(363903 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SMITHKLINE BEECHAM CORPORATION

Opposer,

v.

OMNISOURCE DDS, LLC

Applicant.

:
:
:
:
:
:
:
:
:
:

OPPOSITION NO. 91178539

**OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS
MOTION TO STRIKE APPLICANT'S SUPPLEMENTAL NOTICE OF RELIANCE**

Opposer, SmithKline Beecham Corporation, moved to strike Applicant, Omnisource DDS, LLC's Supplemental Notice of Reliance, because Applicant failed to comply with the Board's Order dated June 10th (the "Order") directing Applicant to correct its initial Notice of Reliance and to resubmit some of the evidence cited therein. Applicant's brief provides no legitimate basis for denying Opposer's motion, and in fact, Applicant did not even respond to many of the issues raised in the motion. Notably, Applicant does not deny that Opposer's motion can be resolved by reviewing the face of Applicant's Supplemental Notice of Reliance. Therefore, Opposer respectfully requests that the Board rule on this motion before the trial period begins.

I. APPLICANT'S DISCOVERY DEPOSITION TESTIMONY SHOULD NOT BE ADMITTED INTO EVIDENCE

A. Applicant Failed to Submit Its Discovery Deposition Testimony Before the Deadline

Applicant admits that the Board ordered it to resubmit the specific portions of the discovery deposition transcript that it intends to rely upon in this proceeding. (*See* Applicant's Supplemental Notice of Reliance at 1.) Applicant's deadline for complying with this directive was July 10th. Because Applicant failed to resubmit its discovery deposition testimony within the time allowed, the evidence should be excluded on this basis alone.

Now that the deadline has passed, Applicant has attempted to get its testimony into the record by attaching it as an exhibit to its brief in opposition to this motion.¹ The rules state that evidence submitted with a brief “can be given no consideration unless [it was] properly made of record during the time for taking testimony.” TBMP 704.05(b). Applicant’s discovery deposition testimony was not properly made of record, because it was not attached to a notice of reliance as required by Rule 2.120(j), and because it was filed more than a month and a half after Applicant’s deadline for submitting such evidence.

Applicant claims that the Board should accept its belated filing, because it previously submitted the entire discovery deposition transcript with its initial Notice of Reliance. But as Opposer noted in its motion to strike, the Order specifically states that Applicant’s prior submission has been stricken from the record. (*See* Opposer’s Brief at 3.) Thus, if Applicant wanted to rely on any portion of that transcript it should have resubmitted the relevant pages on or before the deadline set forth in the Order.

For the foregoing reasons, the Board should strike the section of Applicant’s Supplemental Notice of Reliance which appears under the heading “Exhibit 2” and should give no consideration to the deposition testimony attached as “Exhibit 2” to Applicant’s brief. If the Board grants this request, then it need not consider Section I.B of Opposer’s reply brief and instead may proceed directly to Section II of this brief.

B. Applicant Did Not Provide Sufficient Justification for Admitting Its Discovery Deposition Testimony into Evidence

Even if the Board ignores the fact that Applicant submitted its discovery deposition testimony after the deadline, the Board should not allow this testimony into evidence because Applicant failed to explain why it needs to rely on this testimony in the first place.

¹ Applicant belatedly submitted the pages of the discovery deposition transcript which were cited in its Supplemental Notice of Reliance, but did not submit any of the deposition exhibits which may have been mentioned on these pages. Thus, Applicant has waived its right to rely upon those deposition exhibits.

Applicant's Supplemental Notice of Reliance states that its deposition testimony would be used to rebut one of the interrogatory responses that Opposer cited in its Sixth Notice of Reliance. Opposer has demonstrated that deposition testimony may not be used to rebut statements made in an interrogatory response (or *vice versa*). (See Opposer's Brief at 4-5, 10.) Applicant did not address this issue in its brief. Thus, Applicant has conceded that Opposer's use of Applicant's interrogatory responses provides no basis for allowing Applicant to rely on its own deposition testimony as rebuttal evidence.

Applicant now claims that its deposition testimony would be used solely to respond to the testimony Opposer submitted "regarding Applicant's lack of sales, lack of manufacturing schematics or agreements, lack of marketing materials, and the like." (Applicant's Brief at 2-3, quoting Applicant's Supplemental Notice of Reliance.) However, Applicant did not identify the portions of the transcript that allegedly discuss these issues until after Opposer filed its motion to strike. Even if the Board decides to consider these belated citations, Applicant has not explained why the Opposer's evidence would be misleading or why the Applicant's evidence would be needed to correct any alleged misimpressions "regarding Applicant's lack of sales, lack of manufacturing schematics or agreements, [and] lack of marketing materials." For example, Applicant does not claim that it has made any sales or that it has created any manufacturing schematics, manufacturing agreements, or marketing materials for its product. Nor is there anything in Applicant's brief or its Supplemental Notice of Reliance to suggest that the cited testimony discusses actual sales, actual schematics, actual agreements, or actual marketing materials for the oral irrigator products at issue in this dispute.

The Board warned the Applicant that if it did not provide "a complete explanation" as to "why [it] needs to rely upon each additional part" of its deposition transcript, the Board would "not consider the additional parts" cited in Applicant's Supplemental Notice of Reliance. Because Applicant failed to comply with these directives, the Board should strike the section of Applicant's Supplemental Notice of

Reliance which appears under the heading “Exhibit 2” and should refuse to consider the deposition testimony attached as “Exhibit 2” to Applicant’s brief.

II. APPLICANT’S DENIALS HAVE BEEN EXCLUDED FROM EVIDENCE

Applicant admits that its responses to Opposer’s Requests for Admission Nos. 110, 112, 114, and 116 have been excluded from evidence already, and admits that the Board’s prior ruling on this issue was “clear.” (Applicant’s Brief at 12.) Opposer asked the Board to penalize Applicant for ignoring its prior ruling and suggested that an appropriate sanction would be excluding Applicant’s response to Opposer’s Request for Admission No. 174, since that is the only “admission” cited in Applicant’s Supplemental Notice of Reliance. (*See* Opposer’s Brief at 6.) Applicant did not address this issue in its brief. Therefore, the Board should grant Opposer’s motion as conceded and should give no consideration to the admission or any of the denials cited in Applicant’s Supplemental Notice of Reliance. If the Board grants this request, then it need not consider Section III of Opposer’s reply brief and instead may proceed directly to Section IV below.

III. APPLICANT’S ADMISSION SHOULD NOT BE ADMITTED INTO EVIDENCE

Opposer demonstrated that Applicant’s response to Opposer’s Request for Admission No. 174 should not be admitted into evidence, because Applicant failed to explain why this “admission” would be needed to rebut the evidence that Opposer has submitted. (*See* Opposer’s Brief at 7-8.) Applicant did not respond to any of these arguments in its brief. Therefore, the Board should grant Opposer’s motion as conceded and should exclude Applicant’s response to Opposer’s Request for Admission No. 174.

IV. APPLICANT’S INTERROGATORY RESPONSES SHOULD NOT BE ADMITTED INTO EVIDENCE

A. Applicant’s Response to Interrogatory 7

Opposer demonstrated that Applicant’s response to Interrogatory No. 7 from Opposer’s First Set of Interrogatories should not be admitted into evidence, because Applicant failed to explain why that

response would be needed to respond to the evidence that Opposer has submitted. (See Opposer's Brief at 9.) Applicant claims this issue is moot, because Opposer already submitted Applicant's Response to Interrogatory No. 7 in its Sixth Notice of Reliance. (Applicant's Brief at 12.) While Applicant is correct that Opposer submitted Applicant's Response to Interrogatory No. 7 from Opposer's *Second* Set of Interrogatories, Opposer did not submit Applicant's Response to Interrogatory No. 7 from Opposer's *First* Set of Interrogatories.² (Compare Opposer's Sixth Notice of Reliance Exs. A & B with Opposer's Sixth Notice of Reliance Ex. C.) Because Applicant failed to address this issue in its brief, the Board should grant Opposer's motion as conceded and should refuse to consider Applicant's response to Interrogatory No. 7 from Opposer's First Set of Interrogatories.

B. Applicant's Response to Interrogatory Nos. 6, 8, 9, and 10

In its Supplemental Notice of Reliance Applicant claimed that its response to Interrogatory Nos. 6, 8, 9, and 10 from Opposer's Second Set of Interrogatories would be used to rebut the statements Applicant made in its response to Interrogatory No. 7 from Opposer's First Set of Interrogatories.³ Opposer demonstrated that these responses should not be allowed into evidence, because Applicant failed to explain why its response to Interrogatory No. 7 would be misleading or how the responses to the other interrogatories would be used to rebut that evidence. Applicant did not address any of these arguments in its brief.

² Interrogatory No. 7 from Opposer's Second Set of Interrogatories asked Applicant to identify each product that it intends to offer, sell or distribute under the mark AQUAJETT. (See Opposer's Sixth Notice of Reliance at Ex. C.) By contrast, Interrogatory No. 7 from Opposer's First Set of Interrogatories asked Applicant if it conducted a trademark search before filing its application for this mark. (See Applicant's Supplemental Notice of Reliance at 4-5.)

³ Applicant also claimed that these interrogatory responses would be used to rebut the deposition testimony that Opposer cited in its Fifth Notice of Reliance. As discussed above, interrogatory responses may not be used to rebut statements made in a deposition transcript (or *vice versa*). (See Opposer's Brief at 4-5, 10.) Opposer cited the relevant rules in its motion, but Applicant did not address this issue in its brief. Thus, Applicant has conceded that Opposer's use of Applicant's discovery deposition testimony provides no basis for allowing Applicant to use its own interrogatory responses as rebuttal evidence.

Applicant now claims that these interrogatory responses would also be used to rebut the statements Applicant made in its response to Interrogatory No. 10 from Opposer's First Set of Interrogatories. (Applicant's Brief at 12-13.) Applicant did not mention Opposer's First Interrogatory 10 in its Supplemental Notice of Reliance, and its attempt to use that interrogatory as a basis for introducing its responses to Opposer's Second Interrogatory Nos. 6, 8, 9, and 10 should be denied as untimely.

Even if the Board decides to consider this belated citation, Applicant has failed to explain why its response to Opposer's First Interrogatory 10 is misleading or why it needs to rely on the responses to Opposer's Second Interrogatory Nos. 6, 8, 9, and 10 in order to rebut that evidence. Opposer's First Interrogatory 10 asked Applicant to "State all facts and identify all documents supporting Applicant's assertion . . . that it had . . . a bona fide intention to use Applicant's Mark in commerce in connection with the goods identified in the application." The term "Applicant's Mark" was defined as meaning the mark AQUAJETT. Applicant responded to this interrogatory by stating that its "bona fide intent to use the AQUAJETT mark in commerce is evidence [sic] in Applicant's patent filing and other documents indicating an intention to manufacture dental instruments." (See Applicant's Brief at 13, quoting Opposer's First Interrogatory No. 10; Applicant's Notice of Reliance, Ex. 8, Opposer's First Set of Interrogatories at 5; Opposer's Sixth Notice of Reliance, Ex. B., Applicant's Response to Interrogatory No. 10.)

By contrast, Opposer's Second Interrogatory Nos. 8, 9, and 10 ask Applicant "to identify each product that Applicant intends to offer, sell, or distribute" under the marks OMNIJET, OMNIPK, and AQUAPIK. The products Applicant intends to sell under these marks do not counter or neutralize the Applicant's statement concerning its intent to use the mark AQUAJETT. Simply put, the subjects discussed in Opposer's First Interrogatory No. 10 have nothing to do with the subjects discussed in Opposer's Second Interrogatory Nos. 8, 9, and 10.

The same goes for Applicant's response to Opposer's Second Interrogatory No. 6. This interrogatory asked Applicant to "[e]xplain the basis for [its] contention that oral irrigators are unrelated to toothpaste and toothbrushes." (See Applicant's Brief at 13, quoting Opposer's Second Interrogatory No. 6.) Evidence concerning the relatedness of Opposer's goods and Applicant's goods might be relevant to the issue of confusion, but it has nothing to do with the issue of Applicant's bona fide intent. Thus, Applicant's statements in Interrogatory No. 6. concerning the relatedness of the goods cannot be used to rebut the statements in Interrogatory No. 10 concerning Applicant's bona fide intent.

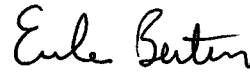
Applicant also claims that its response to Opposer's Second Interrogatory No. 7 should be accepted as rebuttal evidence for the statements set forth in Interrogatory No. 10. Interrogatory No. 7 asked Applicant "to identify each product that Applicant intends to offer, sell, or distribute" under the mark AQUAJETT. Applicant has failed to explain why its response to Opposer's First Interrogatory No. 10 is misleading, or why Applicant needs to rely on its response to Opposer's Second Interrogatory No. 7 in order to counter or neutralize that statement. At best, statements made in Interrogatory No. 7 concerning the product Applicant intends to sell under the AQUAJETT mark would be consistent with the statement made in Interrogatory No. 10 concerning Applicant's bona fide intent to use the mark AQUAJETT. As such, one interrogatory response cannot be used to rebut the other.

Conclusion

For the foregoing reasons, Opposer respectfully requests that the Board grant Opposer's motion and exclude the admission, denials, and discovery deposition testimony cited in Applicant's Supplemental Notice of Reliance, as well as Applicant's response to Interrogatory No. 7 from Opposer's First Set of Interrogatories and Applicant's response to Interrogatory Nos. 6, 8, 9, and 10 from Opposer's Second Set of Interrogatories.

Dated: September 3, 2009

Respectfully submitted,



Glenn A. Gundersen
Erik Bertin
Jacob R. Bishop
DECHERT LLP
Cira Centre
2929 Arch Street
Philadelphia, PA 19104-2808
(215) 994-2183

Attorneys for Opposer
SMITHKLINE BEECHAM CORPORATION

Certificate of Service

I hereby certify that a true and correct copy of Opposer's Reply Brief in Support of Its Motion to Strike Applicant's Supplemental Notice of Testimony has been duly served by mailing such copy first class, postage prepaid, to Erik M. Pelton, Erik M. Pelton & Associates, PLLC, P.O. Box 100637, Arlington, Virginia 22210, on September 3, 2009.



Erik Bertin